

REMARKS

Claims 26-37 have been canceled and claims 38-58 have been added, leaving claims 38-58 for consideration upon entry of the present amendment. Support for the new claims is found in the specification and claims as originally filed. No new matter is introduced by the newly added claims.

The Examiner asserts that the application contains claims directed to more than one species of the generic invention and that the species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicants respectfully traverse.

As the Examiner has stated, this application is subject to the PCT Rules 13.1 to 13.4 (unity of invention). MPEP § 1893.03(d) states: "When making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." Applicants submit that, while the Examiner states he is using unity of invention, it appears that the restriction is based on U.S. practice under MPEP 800. Applicants note that the Examiner has cited MPEP § 809.02(a), which does not apply to this application. Also, the Examiner has cited to 37 CFR § 1.141, which is improper. The proper rule is 37 CFR § 1.499. See paragraph 6 of the office action. See MPEP 1893.03(d).

Under PCT Rules 13.1 and 13.2, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The MPEP, Appendix AI sets forth the Administrative Instructions under the PCT (see Annex B Unity of Invention Part 1, Instructions Concerning Unity of Invention). Those Instructions explain: "Unity of invention has to be considered in the first place only in relation to the **independent** claims in an international application and not the dependent claims." (Emphasis supplied). If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims.

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In particular, it does not matter if a dependent claim itself contains a further invention.

Equally, no problem arises in the case of a genus/species situation where the genus claim avoids the prior art. See Annex B, Unity of Invention, Part 1(c)(i).

In this case, the special technical feature is a substance having both a high neutron capture cross-section and an electrolytically precipitable metallic substance. The Examiner has made a general statement that there is no common "special technical feature" because the general inventive concept as set forth in the claims does not define over the prior art. The Examiner states to "See EP 0 055 679 A2." However, it is not clear how the Examiner is using that reference to state that there is no special technical feature, as the reference is in French and the International Search Report lists the reference as being an "A" reference, which means that the document defines the general state of the art which is not considered to be of particular relevance. Accordingly, the Examiner has not set forth any reason or analysis to support the conclusion that there is no special technical feature.

Applicants urge the Examiner to review the examples concerning unity of invention set forth on pages AI-57 to AI-67. These examples help explain what types of claims satisfy unity of invention.

Applicants have cancelled all claims and written the two independent claims, the first independent claim is a method claim and the second independent claim is an apparatus claim. Both of these independent claims have the special technical feature of a substance having a high neutron capture cross-section and an electrolytically precipitable metallic substance. Accordingly, the method claim and the apparatus claim have unity of invention. See Example 3 on page AI-57 in which unity of invention exists between claims 1 and 2 and claims 1 and 3. In addition, see Example 7 on page AI-58.

Based on the new set of claims and the arguments set forth above, Applicants respectfully request reconsideration and also request that the Examiner withdraw the election/restriction requirement.

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If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

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